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TL 1/25/03 1734

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0533-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

ALAIN BETHUNE et al.)

Application No. 09/506,795)

Filed: February 18, 2000)

For: MATERIAL SUPPLY STRIP,)
SYSTEM, AND METHOD OF)
APPLYING PIECES OF)
MATERIAL TO OBJECTS)

Group Art Unit: 1734

Examiner: G. R. Koch III

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REQUEST FOR RECONSIDERATION

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In response to the Office Action dated December 12, 2002, Applicants respectfully request reconsideration of the application in view of the following remarks. Claims 7, 11, 13, 15, 17-19, 36-72, 74, and 75 were withdrawn from consideration as being directed to a nonelected claim group and/or species. Claims 1-76 are pending.

In the Office Action, claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 2212995 to Schaefer in view of U.S. Patent No. 6,306,475 to Stocq et al. Schaefer discloses a method and device for the production and output of self-stick labels wherein the labels are on both sides of a backing strip. Stocq et al. discloses ultraviolet control of the release of a pressure sensitive adhesive in contact with a silicone release layer.

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To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) based on multiple references, the Examiner must show: (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine teachings of the references; (2) there is a reasonable expectation or success; and (3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success are both found in the prior art and not based on applicant's disclosure. See MPEP § 2142.

Applicants respectfully disagree with the rejection of claim 1 because the combination of Schaefer and Stocq et al. fails to provide a *prima facie* case of obviousness of a "method of applying pieces of material to objects" comprising, *inter alia*, "providing a material supply strip . . . including a backing having first and second opposing surfaces and pieces of material" wherein "the backing and the pieces of material [are] formed of substantially the same material," as recited in claim 1 (emphasis added).

As acknowledged by the Examiner, Schaefer "does not disclose that the backing and the pieces of material are being formed of substantially the same material." (Office Action at ¶ 2, p. 2.) The Examiner relied on Stocq et al. for this feature, however, asserting that it discloses "the formation of labels to utilize the same material for the backing and the pieces (i.e., the labels—see column 3, lines 53-56)." (*Id.*) The Examiner did not cite to any suggestion or motivation, in the prior art, for his proposed modification of Schaefer to include "the backing and the pieces of material being formed of substantially the same material," as recited in claim 1. Indeed, neither Schaefer nor Stocq et al. provides any such suggestion or motivation.

Applicants submit that the § 103(a) rejection of claim 1 based on Schaefer and Stocq et al. should be withdrawn because the cited references contain no teaching or suggestion to modify Schaefer to have a backing and pieces of material formed of substantially the same material. Although Stocq et al. discloses that a "[b]acking sheet can be selected from clear polymeric films, such as those used for the face sheet," it does not disclose any reasons why one of ordinary skill in the art would select backing and face sheets of the same material and does not otherwise provide any suggestion or motivation to modify Schaefer in that way. (Stocq et al., col. 3, ll. 52-53.) As such, without relying on improper hindsight gleaned from the present invention, claim 1 cannot be *prima facie* obvious based on Schaeffer in view of Stocq et al. Accordingly, the § 103(a) rejection of claim 1 should be withdrawn.

Claims 2-5, 8-10, 12, 14, 21, 28, and 73 depend from claim 1 and, therefore, are allowable over the combination of Schaefer and Stocq et al. for at least the same reasons as claim 1.

With respect to claim 76, Applicants respectfully traverse the rejection because the combination of Schaefer and Stocq et al. fails to teach or suggest a "method of applying pieces of material to objects" comprising, *inter alia*, providing a material supply strip with "the pieces of material on the first surface having a different format than the pieces of material on the second surface," and "wherein the pieces of material on the first surface are positioned on the backing substantially opposite to corresponding pieces of material on the second surface such that outer edges of opposing pieces of material do not line up with one another," as recited in claim 76.

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Although the Office Action generally asserted that "Schaefer further discloses the additional limitation that the pieces of material on the first surface are positioned on the backing substantially opposite to corresponding pieces of material on the second surface such that outer edges of the opposing pieces of material do not line up with each other (see Figures)," the Office Action does not cite any disclosure of a supply strip including such features in combination with "pieces of material on the first surface having a different format than the pieces of material on the second surface," as recited in claim 76. (Office Action at ¶ 2, p. 5.) Applicants respectfully submit that neither Schaefer nor Stocq et al. teaches or suggests providing a material supply strip with both of these features, as recited in claim 76. Therefore, the rejection of claim 76 should be withdrawn.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer and Stocq et al. in view of U.S. Patent 5,143,466 to Moncrieff Baldwin et al. Claim 6 depends from claim 1 and, therefore, should be allowable for at least the same reasons as claim 1.

Claims 16, 20, and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer and Stocq et al. in view of U.S. Patent No. 3,861,986 to Wochner. These claims depend from claim 1 and, therefore, are allowable for at least the same reasons as claim 1.

Claims 22, 24-26, and 29-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer and Stocq et al. in view of U.S. Patent No. 6,379,761 to Brandt et al. These claims depend from claim 1 and, therefore, are allowable for at least the same reasons as claim 1.

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Claims 23 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer and Stocq et al. in view of U.S. Patent No. 5,376,417 to Amano et al. These claims depend from claim 1 and, therefore, are allowable for at least the same reasons as claim 1.

Claim 28 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaefer and Stocq et al. in view of Brandt et al. and U.S. Patent No. 5,569,540 to Hirose et al. Claim 28 depends from claim 1 and, therefore, is allowable for at least the same reasons as claim 1.

Claims 7, 11, 13, 15, 17-19, and 72 were withdrawn from consideration as being directed to non-elected species. Because each of these claims depends from an allowable generic claim (e.g., claim 1), Applicants respectfully request that the Examiner rejoin, examine, and allow each of these claims.

If a telephone conversation might advance prosecution of the application, the Examiner is invited to call Applicants' undersigned attorney at (202) 408-4000.

The Office Action contains characterizations of the invention, the claims, and the related art, with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

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To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17, which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: January 21, 2003

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